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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,976	10/02/2003	Shinji Sato	380-42	6278

23117 7590 11/29/2005

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ARLINGTON, VA 22203

EXAMINER
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THERKORN, ERNEST G

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/675,976

Applicant(s)

SATO ET AL.

Examiner

Ernest G. Therkorn

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Claims 5-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No support can be found for "successive steps". There is no support in the specification for excluding steps between eluting, detecting cations, and preparing a chromatogram. As such, the claims are considered to be drawn to new matter.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 6 are rejected under 35 U.S.C. 102(B) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hajos (Journal of Chromatography, 1997, pages 141-148). The claims are considered to read on Hajos (Journal of Chromatography, 1997, pages 141-148). However, if a difference exists between the claims and Hajos (Journal of Chromatography, 1997, pages 141-148), it would reside in optimizing the steps of Hajos (Journal of Chromatography, 1997, pages 141-148). It

would have been obvious to optimize the steps of Hajos (Journal of Chromatography, 1997, pages 141-148) to enhance analysis.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hajos (Journal of Chromatography, 1997, pages 141-148) in view of either Japan 06-018505 or Japan 08-257419. At best, the claims differ from Hajos (Journal of Chromatography, 1997, pages 141-148) in reciting use of the particular acid. Japan 06-018505 in paragraph 40 of the translation submitted by applicant discloses that phosphoric acid is a desirable acid eluent for cation analysis. Japan 08-257419 in paragraph 26 of the translation submitted by applicant discloses nitric acid is a desirable acid eluent for cation analysis. It would have been obvious to use either nitric or phosphoric acid as the particular acid in Hajos (Journal of Chromatography, 1997, pages 141-148) either because Japan 06-018505 in paragraph 40 of the translation submitted by applicant discloses that phosphoric acid is a desirable acid eluent for cation analysis or because Japan 08-257419 in paragraph 26 of the translation submitted by applicant discloses nitric acid is a desirable acid eluent for cation analysis.

The remarks urge patentability based upon the allegation that claims 5-8 exclude ion suppression chromatography. However, the open ended term "comprising" is considered to permit steps between eluting, detecting cations, and preparing a chromatogram. In any event, page 141, the sentence bridging column 1 and 2 of Hajos (Journal of Chromatography, 1997, pages 141-148) discloses that it is well known to have nonsuppressed ion chromatography. It would have been obvious to delete the suppression step along with its function in Hajos (Journal of Chromatography, 1997,

pages 141-148). Lastly, no support can be found for "successive steps". There is no support in the specification for excluding steps between eluting, detecting cations, and preparing a chromatogram. As such, the term "successive steps" is considered to be drawn to new matter.

The remarks appear urge that deletion of the ion suppressor yield improved peak shape. However, this is an allegation unsupported by fact.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (571) 272-1149. The official fax number is 571-273-8300.

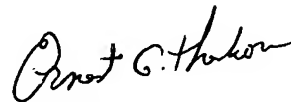
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Ernest G. Therkorn".

**Ernest G. Therkorn**  
**Primary Examiner**  
**Art Unit 1723**

EGT  
November 23, 2005